



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,893	06/29/2001	Michael Joseph Calderaro	AUS9-2001-0233-US1	7074

40412 7590 07/12/2005

IBM CORPORATION- AUSTIN (JVL)
C/O VAN LEEUWEN & VAN LEEUWEN
PO BOX 90609
AUSTIN, TX 78709-0609

EXAMINER

STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,893

Applicant(s)

CALDERARO ET AL.

Examiner

Johnna R. Stimpak

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29/01, 3/8/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: 1449 6/8/04.

DETAILED ACTION

1. The following is a first office action upon examination of application number 09/895,893.

Claims 1-20 are pending and have been examined on the merits discussed below.

Claim Rejections - 35 USC §101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, recited steps of receiving planning factor data, and employment data, analyzing the data and copying the data to an employee profile data area does not apply involve,

Art Unit: 3623

user or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to manipulate employee and planning factor data.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the recited steps receive and store planning factor data and employee data and analyze and copy the data to an employee profile (useful, tangible and concrete).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Paizis, US 6,338,042.

As per claim 1, Paizis teaches receiving planning factor data from a user, the planning factor data corresponding to one or more employees (column 6; 50-56 – pay data for employees

Art Unit: 3623

is entered into the payment program); storing the planning factor data in employee profile data areas, wherein each employee profile data area corresponds to one of the employees (column 6, lines 57-67 – target pay for each employee is computer and inherently stored for later comparison); storing actual employment data for each of the employees in the employee profile data areas (column 5, lines 49-59 – employee performance data is stored for later comparison); analyzing the planning factor data (column 7, lines 35-40 – the pay data is compared against the budget); and copying one or more planning factors from at least one of the employee profile data areas to the actual employment data corresponding to the employee profile data areas (figs 5A and 5B show pay and employee performance data stored in tables wherein the data correlates to each employee).

As per claim 2, Paizis teaches determining budget planning data for a group of employees (column 7, lines 35-40 – a budget is used in comparing target pay to determine pay allocation); storing the determined budget planning data (column 7, lines 35-40 – inherently the budget data is stored since it is compared to target pay information to determine pay allocation and/or increases); comparing the budget planning data with the planning factors corresponding to the group of employees (column 7, lines 35-40 – the pay data is compared against the budget); and Revising the planning factors data corresponding to at least one employee selected from the group of the employees in response to the comparison (column 7, lines 41-55 – the pay targets are compared to the budget and a determination is made of whether the pay targets are acceptable or if they need to be modified).

As per claim 3, Paizis teaches selecting one of the employees (column 5, lines 34-67 – for each employee performance evaluation data is obtained); comparing actual data corresponding to

Art Unit: 3623

the selected employee with actual employment data corresponding to one or more other employees (column 5, line 34 – column 6, line 34 – the performance data for each employee is obtained and ranked to determine appropriate pay); and revising the planning factors data corresponding to the selected employee in response to the comparison (column 6, lines 34-67 – a determination can be made that the rankings must be changed, once the rankings are determined, target pay for each individual is computer based on the rankings).

As per claim 4, Paizis teaches the actual data includes performance evaluation data (column 5, lines 49-59 – performance evaluations are used to evaluate target pay) and wherein the planning factors include compensation planning data (column 5, lines 49-59 – performance evaluations are used to evaluate target pay).

As per claim 5, Paizis teaches displaying a summary of actual employment data and planning factors data for a group of employees, wherein the group of employees corresponds to a manager on a display device (fig 5A – and column 9, lines 7-53 – a file is stored containing employee information including salary data and evaluation data, it is displayed on a spreadsheet as shown in fig 5A); displaying one or more first summary options corresponding to the displayed summary on the display device (fig 5A – all competency scores are displayed after performance evaluation takes place); receiving a summary option selection corresponding to one of the first summary options from the user (fig 5A – user has option to click on the RANK button to rank employees by combined score); summarizing the actual employment data and planning factors data for the group of employees in response to the received summary option creating a new summary (fig 5A – upon selecting the RANK button, a new summary is created with a ranked list of employees); determining one or more second summary options corresponding to

Art Unit: 3623

the new summary (fig 5C – once employees are ranked, the user can choose to modify the target pay to fit within the designated budget by selecting the MODIFY button); displaying the new summary and the second summary options on the display device (fig 5C – with the ranked employees, a MODIFY button is available wherein uniform changes are made reducing all pay targets by the same percentage to meet budget); and receiving a second summary options corresponding to one of the second summary options from the user (fig 5C – the MODIFY button produces a new summary wherein all pay is modified to meet the budget).

As per claim 6, Paizis teaches the analysis is selected from the group consisting of risk assessment analysis, compensation analysis, and performance analysis (column 5, lines 49-59 – performance evaluations are used to evaluate target pay).

As per claim 7, Paizis teaches copying one or more compensation planning factors from at least one of the employee profile data areas to the actual employment data corresponding to the employee profile data; and clearing the copied compensation planning factors. (fig 5B – the compensation planning data is shown wherein the targets are set including target pay, current pay rank, user then proceeds to step 4; fig5C shows step 4 wherein the compensation planning factors are removed and final pay, etc., are shown and option to modify is displayed)

Clearing the copied compensation planning factors.

Claims 8-13 are the information handling system to perform the method of claims 1-5 and 7. Since Paizis teaches a system used to manage employee evaluation and pay data, the same rejections as applied to claims 1-5 and 7 are also applied to claims 8-13.

Art Unit: 3623

Claims 14-20 are the computer program product for performing the method of claims 1-7. Since Paizis teaches computer software for managing employee evaluation and pay data, the same rejections as applied to claims 1-7 also apply to claims 14-20.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Richman, US 6,754,874 – computer-aided system and method for evaluating employees

Tremaine, US 5,819,231 – compensation planning tool and method

Grimse, US 6,269,355 – automated process guidance system and method using knowledge management system

Zitaner et al, US 6,741,993 – competitive rewards benchmarking system and method

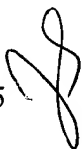
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS
7/9/05



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600